



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: Sellen et al.
Serial No.: 09/773,090
For: TEXT PROCESSING SYSTEM
Filed: 31 JAN 2001
Examiner: Chau T. Nguyen
Art Unit: 2176
Confirmation No.: 6082
Customer No.: 27,623 Attorney Docket No.: 30003278

REPLY BRIEF FILED UNDER 35 U.S.C. §134

Mail Stop Appeal Brief – Patents
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On 25 JAN 2005, the Office mailed a Final Office Action for the above-noted application. On 25 JUL 2005, Appellants filed an Appeal Brief. On 20 OCT 2005, the Office mailed an Examiner's Answer. Appellants are submitting the present Reply Brief in response to the Examiner's Answer.

This Reply Brief is being filed under 35 U.S.C. §134 and in accordance with the provisions of 37 C.F.R. 41.41. The Examiner's Answer does not raise any new grounds of

rejection of the claims, however the Examiner does raise new points of argument. This brief is directed only to the new points of argument.

Claims 1 – 8 and 10 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,727,894 to Karidis et al. (hereinafter "the Karidis et al. patent") in view of U.S. Patent No. 6,396,598 to Kashiwagi et al. (hereinafter "the Kashiwagi et al. patent").

Before addressing the new points of argument raised in the Examiner's Answer, Appellants wish to note an ambiguity in the Office's application of the Karidis et al. patent.

Claim 1 provides for a text processing unit. The text processing unit includes, *inter alia*, a first text editing unit having a screen, and a second text editing unit having a second screen.

The Final Office Action, on page 3, with reference to the Karidis et al. patent, equated recording unit 101 to the second text editing unit of claim 1, and noted that recording unit 101 includes a display, namely LCD 108. Thus, it appears that the Office was equating LCD 108 to the second screen of claim 1. The Examiner's Answer, on page 4, with reference to the Karidis et al. patent, again appears to equate LCD 108 to the second screen of claim 1. However, pages 11 - 12 of the Examiner's Answer, with reference to the Karidis et al. patent, equates markable surface 150 to the second screen of claim 1.

In the Appeal Brief, on page 12, Appellants explained that display 108 is not an equivalent of the second screen of claim 1. Appellants are standing by that explanation, and so, will not repeat the explanation in the present document. However, below, Appellants explain that markable surface 150 is also not an equivalent of the second screen of claim 1.

The Examiner's Answer, page 11, argument (A) takes issue with Appellants' argument that the Karidis et al. patent does not disclose a second text editing unit having a second screen

upon which text may be displayed. It is here that the Examiner's Answer equates markable surface 150 to the second screen of claim 1.

The Karidis et al. patent expressly describes recording unit 101 as having two displays, namely display 202 and display 108. The Karidis et al. patent further describes display 202 as being, for example, an LCD or thin film transistor "TFT" active panel or display screen (col. 6, lines 3 – 4). Markable surface 150 is described as a sheet or pad 160 of paper (col. 7, line 26) and col. 8, line 4). Thus, the Karidis et al. patent distinguishes between a display (i.e., displays 202 and 108) and a sheet of paper (i.e., markable surface 150). The Examiner's Answer is apparently arguing that a sheet of or pad paper (i.e., markable surface 150) is the equivalent of a screen upon which text may be displayed.

Whereas the Karidis et al. patent expressly describes displays 202 and 108 as being TFT or LCD displays, and expressly describes markable surface 150 as being a sheet or pad of paper, Appellants submit that the Karidis et al. patent does not contemplate a sheet or pad of paper (i.e., markable surface 150) as being either of a display or a screen on which text may be displayed. Thus, the Karidis et al. patent does not disclose a second text editing unit having **a second screen upon which text may be displayed**, as recited in claim 1.

The Examiner's Answer, page 12, argument (B) takes issue with Appellants' argument that the Kashiwagi et al. patent does not disclose or suggest that text selected from a first document displayed on one unit is to be inserted directly at a predetermined location in a document displayed on another unit, and that all of the embodiments of the Kashiwagi et al. patent disclose a display of only one document on one screen.

Page 5 of the Examiner's Answer, recognizes that the Karidis et al. patent does not explicitly disclose text selected from a first document displayed on one unit to be inserted directly at a predetermined location in a document displayed on the other unit, as recited in claim 1. Thus, the Examiner's Answer introduces the Kashiwagi et al. patent and equates a tablet 66 to a

display. The Examiner's Answer, page 12, last sentence – page 13, first sentence, reiterates that the Office's position that tablet 66 of the Kashiwagi et al. patent is considered as a first unit or screen.

The Kashiwagi et al. patent describes a see through display device 68 (col. 10, line 62), and explains that an electronic memo written on tablet 66 is displayed on see through display device 68 (col. 10, line 66 – col. 11, line 1). The Kashiwagi et al. patent expressly describes tablet 66 as an input device (col. 11, line 24).

Whereas the Kashiwagi et al. patent expressly describes see through display device 68 as displaying the memo, expressly describes the memo as being written on tablet 66, and expressly describes tablet 66 as being an input device, the Kashiwagi et al. patent does not contemplate tablet 66 as a unit for displaying a document. Thus, the Kashiwagi et al. patent does not disclose text selected from a first document **displayed** on one unit to be inserted directly at a predetermined location in a document displayed on the other unit, as recited in claim 1.

The Examiner's Answer, page 13, argument (C) takes issue with Appellants' argument that there is no motive to combine the Karidis et al. and Kashiwagi et al. patents. More particularly, page 13 of the Examiner's Answer states that the Karidis et al. patent and the Kashiwagi et al. patent are analogous arts, and then page 14 concludes that it would be obvious to combine these two patents to provide a user friendly environment that allows a plurality of users to add text from one device to another.

Both of the Karidis et al. and Kashiwagi et al. patents are directed toward apparatuses that enable a user to provide input in written form, for insertion into a document. In the Karidis et al. patent, the user provides input via markable surface 150. In the Kashiwagi et al. patent, the user provides input via tablet 66. Both of the Karidis et al. and Kashiwagi et al. patents fully provide for the receipt and processing of input from the user. Neither of the Karidis et al. patent nor the Kashiwagi et al. patent have any apparent need for another screen upon which text may be

displayed, with which the user can interact. Thus, neither of the Karidis et al. patent nor the Kashiwagi et al. patent provides any motive for a second screen upon which text may be displayed, and a second manual actuator by means of which a user is able to interact with text displayed on the second screen, as recited in claim 1. For these several reasons, Appellants maintain that there is **no motive** for the cited combination of the Karidis et al. and Kashiwagi et al. patents.

The Examiner's Answer, page 14, argument (D) notes that Appellants did not make any arguments for claims 10 and 15, but instead, underlined phrases in claims 10 and 15 that are similar to phrases recited in claim 1. Appellants are maintaining that claims 10 and 15 are patentable over the cited combination of references for reasons similar to those provided in support of claim 1.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Karidis et al. and Kashiwagi et al. patents further in view of U.S. Patent No. 6,704,024 to Robotham et al. (hereinafter "the Robotham et al. patent").

The Examiner's Answer, page 14, discussion of claim 9, takes issue with Appellants' argument that the Robotham et al. patent does not make up for the deficiencies of the Karidis et al. and Kashiwagi et al. patents as they relate to claim 1. More particularly, the Examiner's Answer states that the Examiner does not use the Robotham et al. patent to reject claim 1, and therefore, Appellants cannot argue that the Robotham et al. patent on claim 1.

Claim 9 depends from claim 1. Thus, claim 9 implicitly includes the recitals of claim 1. Whereas claim 1 is patent able over the cited combination of the Karidis et al. and Kashiwagi et al. patents, and whereas the Robotham et al. patent does not disclose the features of claim 1 that are lacking in the Karidis et al. and Kashiwagi et al. patents, claim 1 is patentable over the cited combination of the Karidis et al., Kashiwagi et al. and Robotham et al. patents. **Claim 9, by**

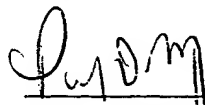
virtue of its dependence on claim 1, is also patentable over the cited combination of the Karidis et al., Kashiwagi et al. and Robotham et al. patents.

Appellants respectfully request that the Board of Appeals reverse the final rejections of the claims, thereby enabling all of the pending claims to be allowed.

Respectfully submitted,

Date

12/19/05



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